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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/489,079	01/21/2000	Patricia A. Billing-Medcl	6451.US.PI	5338

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EXAMINER

EPPS; JANET L

ART UNIT	PAPER NUMBER
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1635

DATE MAILED: 01/18/2002

18

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/489,079

Applicant(s)

BILLING-MEDEL ET AL.

Examiner

Janet L Epps

Art Unit

1635

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 04 January 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 04 January 2002. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:


Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 52-61, 70, and 77-81 remain rejected for the reasons of record.

Claim(s) withdrawn from consideration: 62-69 and 71-76.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____


SEAN MCGARRY
PRIMARY EXAMINER

Continuation of 2. NOTE: 4. Claims 52-61, 70, and 77-81 remain rejected under 35 USC 112, first paragraph, for the reasons of record set forth in the Official Action mailed 10-24-2000, in the rejection of claims 23-25, 28-29, 36-37, 39-40, and 51 under 35 USC 101 and 35 USC 112, first paragraph. Applicant's arguments filed 1-04-02 have been fully considered but they are not fully persuasive. Applicant's arguments are persuasive to the extent that they provide sufficient evidence to demonstrate a potential utility for the polypeptides of the present invention. However, it remains that the instant claims read on a simple detection of the polypeptides, and not on a method of diagnosing a disease since the detection method would result in both normal and diseased tissue since the polypeptide is expressed in both.

Claims 52-61 remain rejected under 35 U.S.C. 112, first paragraph, for lack of sufficient written description for the reasons of record in the Office Action mailed 9-04-01. Applicants traversed this rejection in the reply filed 1-04-02 by presenting evidence that the prior art provides methods for identifying proteins having 95% homology to the sequences of the present invention. However, since there is no functional language recited in the claims of the present invention, it is unclear how one of skill in the art would be able to clearly distinguish the members of the claimed genus of polypeptides. The scope of the claims includes numerous structural variants, and the genus is highly variant because a significant number of structural differences between the genus members are permitted, and neither the specification nor the claims provide any guidance as to what specific changes should be made.

The rejection of Claim 80, under 35 USC 112, second paragraph for the reasons of record, since Applicants did not provide an adequate response to this rejection, other than to address the "epitope" language. The rejection is maintained since the claim remains unclear since an "immunogenic polypeptide" is not a DNA molecule

Continuation of 3. Applicant's reply has overcome the following rejection(s): The rejection of claims 52-61, 70, and 77-81 under 35 USC 101 is withdrawn.